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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,704	10/28/2003	Yoshiyuki Abe	KAM 20.716 (100799-00087)	5210
26304	7590	05/18/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			KOPEC, MARK T	
			ART UNIT	PAPER NUMBER

1751

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,704

Applicant(s)

ABE ET AL.

Examiner

Mark Kopec

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 4-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This action is responsive to applicant's amendment/remarks filed 02/21/06. Claims 1, 2, and 4-20 are currently pending.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-13 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, the terminology "...to the metal plate" has no antecedent basis.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2 and 4-20, are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 09-209134.

This rejection is maintained for the reasons set forth at page 3-4 of the Rejection mailed 09/20/05.

Applicant's remarks regarding this rejection are noted.

Applicant argues that JP '134 teaches Ti only as an optional element, and not as an essential element as required

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(pages 1-2 of remarks). Additionally, applicant states JP '134 does not teach the claimed atomic ratio(s) of Ti/In.

The examiner respectfully submits that a close inspection of JP '134 Examples 11 and 17 discloses atomic ratios within the claimed range. The references also disclose the claimed density and resistivity requirements (see para 0016 and 0021 of JP '134). Although other examples of the reference do not contain Ti, or recite resistivity values or atomic ratios outside the scope of the instant claims, one of ordinary skill in the art would only have to reproduce the above examples in order to meet the instant claim limitations. The reference is anticipatory.

Additionally, applicant's discussion of starting material particle size and resultant phase formation is noted (page 2-3 of remarks). It appears from applicant's discussion (and examples) that utilizing starting powders of approximately 1 micron result in the claims phases structure. Note that JP'134 discloses use of 1 micron starting powder (example 1). The examiner respectfully maintains that the reference would inherently meet the claimed Ti phase limitations (instant claims (5, 7, 15, 16)).

Claims 1, 2, 4, 6-8, 10-14, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 7-54132.

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This rejection is maintained for the reasons set forth at page 3-4 of the Rejection mailed 09/20/05.

Applicant's remarks regarding this rejection are noted.

Note that instant claims 5, 9 and 15-18 are allowed over this reference. The reference does not disclose or suggest the claimed features, nor are such an inherent certainty.

With respect to the remaining claims, applicant argues that JP '132 teaches Ti only as an optional element, and not as an essential element as required (pages 1-2 of remarks).

Additionally, applicant states JP '134 does not teach the claimed atomic ratio(s) of Ti/In or resistivity values.

The examiner respectfully submits that a close inspection of JP '132 Table discloses In/Ti atomic ratios within the claimed range. The references also disclose the claimed density and resistivity requirements (see para 0012, 0013, Table 2 of JP '132). Although other examples of the reference do not contain Ti, or recite resistivity values or atomic ratios outside the scope of the instant claims, one of ordinary skill in the art would only have to reproduce the above examples in order to meet the instant claim limitations. The reference is anticipatory.

Applicant also argues that the "objects of the inventions" are entirely different, and would not lead one of ordinary skill in the art to arrive at the present invention. The examiner

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respectfully disagrees. Both prior art references are drawn to the formation of doped ITO sputtering targets. The prior art specifically teaches that properties such as density, resistivity, transparency and surface properties may be tailored in order to arrive at products giving optimum results. In any event, no motivation is necessary with an anticipation rejection. The skilled artisan would merely have to reproduce the above examples in order to meet the instant claim limitations.

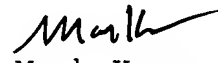
In view of the foregoing, the above claims have failed to patentably distinguish over the applied art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Kopec whose telephone number is (571) 272-1319. The examiner can normally be reached on Monday - Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Mark Kopec
Primary Examiner
Art Unit 1751

MK

May 15, 2006